

## **REMARKS**

### **Specification**

The specification has been amended to capitalize and identify the trademarks TET-ON® and TET-OFF®. The specification has also been amended to disclose the presence of a color drawing, pursuant to 37 C.F.R. § 1.84. Also attached as Exhibit C is a copy of the Preliminary Amendment filed June 19, 2005. Applicants respectfully point out that the language required for use of a color drawing was also included in the previously filed preliminary amendment. No new matter has been added to the specification by these amendments. Applicants respectfully request withdrawal of the objection.

### **Claims**

By entry of the amendments made herein, Claims 1-32 are pending. Claims 1-26 and 31 have been withdrawn as directed to non-elected subject matter.

Claim 27 has been cancelled with entry of the above amendments to the claims. Applicants expressly reserve the right to pursue any cancelled subject matter in this application or in one or more continuing applications.

Claim 28 has been amended. Support for the amendment can be found throughout the specification, drawings and claims as originally filed. Accordingly, Applicants submit that no new matter has been introduced.

Claim 32 has been added. Support for claim 32 can be found throughout the specification, drawings and claims as filed. For example, see page 2, paragraphs [0012] and [0013]; page 5, paragraph [0055]; page 7, paragraph [0070] and page 8, paragraph [0076]. Claim 28 is amended herein. Support for the amendments can be found throughout the specification and claims as originally filed. Accordingly, no new matter has been added.

Entry and consideration of the amendments to the claims is proper and is respectfully requested.

### **Drawings**

The office action states that "Color photographs and color drawings are not accepted unless a petition filed under 37 CFR 1.84(a)(2) is granted". Applicants respectfully draw the Office's attention to the following Exhibits:

**Exhibit A** – a petition for acceptance of color drawings [37 C.F.R. §1.84(a)(2)], dated June 19, 2005 and stamped *Rec'd PCT/PTO 21 Jun 2005*; and

**Exhibit B** - a decision under CFR 1.137(b) which states:

The enclosed "Petition For Acceptance of Color Drawings [37 C.F.R. §1.84(a)(2)]" will be held in abeyance pending the completion of the 35 U.S.C. 371 requirements and then forwarded to the appropriate Group Art Unit for a decision by the Supervisory Patent Examiner pursuant to M.P.E.P. § 1002.02(d)(9)."

Applicants respectfully submit that the requirements of 35 USC §371 have been satisfied. Further, Applicants have paid the required fee of \$130 and amended the specification to include the language required under 37 C.F.R. § 1.84. Thus, Applicants respectfully request that the Office review the petition filed under 37 C.F.R. 1.84(a)(2).

### **Claim Objections**

The Office has objected to claim 27 based on the misplacement of the term "respectively". Claim 27 has been canceled rendering the objection moot.

### **Claim Rejections under 35 U.S.C. § 112, Second Paragraph**

Claims 27-30 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Claims 28-30 stand rejected because they depend from claim 27.

Claim 27 has been cancelled herein and replaced with newly added claim 32. Claims 28-30 now depend from claim 32. Applicants respectfully submit that claim 32 meets all of the requirements under 35 U.S.C. § 112, second paragraph. As claims 28-30 depend from claim 32, Applicants respectfully submit that claims 28-30 also satisfy §112, second paragraph.

**Claim Rejections under 35 U.S.C. § 103(a)**

Claims 27-30 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yeung *et al.* (Molecular and Cellular Biology, Vol. 21, No. 21, p. 7207-7217, November 2001) in view of Welch *et al.* (JBC, Vol. 273, No. 18 p. 11248-11256, 1 May 1998) and in view of Technical Bulletin No. 281 (Promega Corp., p. 1-13, 2002). This rejection is respectfully traversed for at least the following reasons.

First, claim 32 discloses “a cell line *stably transfected* with a reporter gene...” Yeung, *et al.* teaches “... cells [that][were] *transiently transfected* with the indicated expression plasmids...” (*see*, p. 7208, col. 2). Yeung does not teach, suggest, or otherwise motivate one skilled in the art to utilize a cell line stably transfected with a reporter gene. Without a disclosure that teaches, suggests, or otherwise motivates one of skill in the art to utilize a cell line stably transfected with a reporter gene, Yeung cannot be said to render the present claims obvious. Further, none of the additional art cited by the Office overcomes this deficiency, alone or in combination with Yeung.

Second, the assay disclosed in claim 32 further requires exposing the cell lines to “a plurality of test compounds”. However, Yeung only discloses exposing the cell line to a single active agent, (p. 7210, FIG. 2 legend). The Yeung cells were not exposed to a plurality of *test* compounds (emphasis added). Without a disclosure that teaches, suggests, or otherwise motivates one of skill in the art to expose a cell line to a plurality of compounds, Yeung cannot be said to render the present claims obvious. Further, none of the additional art cited by the Office overcomes this deficiency, alone or in combination with Yeung.

For at least these reasons, Applicants therefore respectfully request withdrawal of the rejection.

**CONCLUSION**

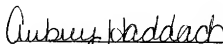
Applicants respectfully solicit the Examiner to expedite prosecution of this patent application to issuance. Should the Examiner have any questions, the Examiner is encouraged to telephone the undersigned. The Commissioner is hereby authorized to charge any additional fees that may be required, or credit any overpayment to Deposit Account No. 232415 (Attorney Docket No. 18545-716.831).

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI  
Professional Corporation

Date: February 18, 2009

By:



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Hong et al. Examiner : tba  
Serial No. : tba Group Art Unit : tba  
Int'l Pat. App. No. : PCT/US02/40757  
Int'l Filing Date : December 19, 2002  
Title : PARALLEL INDUCIBLE CELL-BASED KINASE SCREEN

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

PETITION FOR ACCEPTANCE OF COLOR DRAWINGS [37 C.F.R. §1.84(a)(2)]

Sir:

Applicants submit this petition pursuant to 37 C.F.R. §1.84(a)(2) to request that the Commissioner accept the enclosed sheet of color drawings (Fig. 10) in connection with the above-referenced national stage patent application.

The color drawing is necessary to disclose the subject matter sought to be patented, because the properties associated with the otherwise identical points in the scattergram of Figure 10 are not readily disclosed in any other way. Because each colored element is a point, the shading symbols provided for in the M.P.E.P. § 608.02 cannot be used to illustrate the invention.

Three copies of the color drawing, and a gray-scale photocopy, are enclosed. A preliminary amendment filed herewith introduces the language required by § 1.84(a)(2)(iii). A check in payment of the \$130 petition fee set forth in 37 C.F.R. §1.17(h) is enclosed.

Respectfully submitted,

BROWN RAYSMAN MILLSTEIN FELDER  
& STEINER LLP

by:



James P. Demers  
Reg. No. 34,320

Dated:

June 19, 2005

BROWN RAYSMAN MILLSTEIN FELDER & STEINER LLP  
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Exhibit B

UNITED STATES PATENT AND TRADEMARK OFFICE

15 DEC 2005

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

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In re Application of :  
HONG, et al. : DECISION ON PETITION  
Application No.: 10/540,277 :  
PCT No.: PCT/US02/40757 : UNDER 37 CFR 1.137(b)  
Int. Filing Date: 19 December 2002 :  
Priority Date: None :  
Atty. Docket No.: 6319-4017 :  
For: PARALLEL INDUCIBLE CELL-BASED :  
KINASE SCREEN :

The petition to revive under 37 CFR 1.137(b) filed 21 June 2005 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has now provided payment of the full, U.S. Basic National Fee. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for the preparation and mailing of a "Notification of Missing Requirements" (Form PCT/DO/EO/905) informing applicant that an executed oath or declaration of the inventors and payment of the appropriate surcharge is required.

The enclosed "Petition For Acceptance of Color Drawings [37 C.F.R. §1.84(a)(2)]" will be held in abeyance pending the completion of the 35 U.S.C. 371 requirements and then forwarded to the appropriate Group Art Unit for a decision by the Supervisory Patent Examiner pursuant to M.P.E.P. § 1002.02(d)(9).

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|              |                      |
|--------------|----------------------|
| Docket Date  | RECEIVED DEC 20 2005 |
| BRMFS#       | 6319-4017 US         |
| Attorney(s): | HB/MN/DMS/JPD        |
| Action:      | PETITION GRANTED     |
| Action Date: |                      |
| Final:       |                      |
| Initials:    | MP                   |

Exhibit C

Attorney Docket No. 6319-4017

10/540277  
JC17 Rec'd PCT/PTO 21 JUN 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Hong et al. Examiner : tba  
Serial No. : tba Group Art Unit : tba  
Int'l Pat. App. No. : PCT/US02/40757  
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Title : PARALLEL INDUCIBLE CELL-BASED KINASE SCREEN

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PRELIMINARY AMENDMENT

Sir:

Prior to examination of the above-identified patent application, please amend the drawings as follows:

**An amendment to the specification begins on page 2 of this paper.**

**Amendments to the drawings begin on page 3 of this paper, and include two attached replacement sheets.**

**Remarks begin on page 4.**

*Amendment to the specification:*

On page 1, before "Field of the Invention", please add the following new paragraph:

— The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee. —



10/540277

JC17 Rec'd PCT/PTO 21 JUN 2005

Amendments to the drawings:

The attached sheets 3/6 (in duplicate) and 6/6 (in triplicate) contain amendments to Figure 6 and Figure 10, respectively. Please substitute the attached sheets for the corresponding originals.

A gray-scale copy of the color figure on sheet 6/6 is also enclosed, in compliance with the requirements for submission of color drawings set forth in 37 CFR 1.84(a)(2).

Remarks:

Figure 6 on drawing sheet 3/6 is an image of a Western blot. The image as reproduced in the published PCT application is illegible. The amended drawing provides an enhanced copy of the image that was included with the originally-filed international application.

Figure 10 on drawing sheet 6/6 is a reproduction of a color-encoded scattergram. As reproduced in the published PCT application, the information encoded by the color scheme is not readily discernable. The amended drawing is in color, and is a scanned image of a colored scattergram which was found in the file transferred from the original attorneys to the undersigned attorney. That scattergram is identical in all respects, with the exception of the color, to the image provided with the original international application. In the amended drawing provided herewith, the axis labels and the color legends have been re-typed for clarity.

The specification has been amended to refer to the color drawings, in compliance with 37 CFR 1.84(a)(2). A petition and fee for acceptance of a color figure are filed herewith.

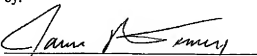
It is believed that the above amendments do not introduce new matter, and Applicants respectfully request entry of these amendments prior to examination.

Respectfully submitted,

BROWN RAYSMAN MILLSTEIN FELDER  
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by:

Dated: June 19 2005



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